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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,155	08/10/2001	Akira Sakaguchi	JP920000246US1	4066

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EXAMINER	
DEBROW, JAMES J	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/927,155	SAKAGUCHI ET AL.	
	Examiner	Art Unit	
	James J. Debrow	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4 pages; 3/17/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed on 10 August 2001.

2. Claims 1-19 are pending in this case. Claims 1, 6, 8, 11, 13, 16, 17, 18, 19 are independent claims.

Claim Objections

3. Claim **1** is objected to because of the following informalities: In the last line of the claim, applicant used the term "said plurality of hosts", wherein he previously used the term "said plurality of interconnected hosts". Applicant should be consistent in using this term throughout the claim. Appropriate correction is required.

4. Claim **13** is objected to because of the following informalities: In line 11 of the claim, applicant used the term "said annotation", as oppose to using the term "said annotation object" as previously used in invention claims. The examiner assumes this was an inadvertent error by the applicant. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **16-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as containing only non-functional descriptive material with no tangible results.

In regards to independent claims 16-18, claims are rejected because they appear absent recitation of any code or steps for causing a computer to anything, instead just ensuring there's no code or steps which prohibit it, there does not appear to be a useful, concrete and tangible result. Changing the word "permits/permitting" in the preamble to "causing a computer to perform:" would overcome this rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims **16-18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to **independent claims 16-18,** it is unclear what Applicant's intended metes and bounds of a claim are. The claims appear to cover anything and everything that does not prohibit actions from occurring. Changing the word "permits/permitting" in the preamble to "causing a computer to perform:" would overcome this rejection.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (US 6,262,728 B1; Date of Patent: Jul. 17, 2001; Effective Filing Date: Nov. 3, 1998) in view of Eintracht et al. (US 6,687,878 B1; Date of Patent: Feb. 03, 2004; Effective Filing Date: Mar. 15, 1999).

With respect to independent claims 1, 6, 8, 11, 13, and 16-19, Alexander discloses a computer system for annotating a graphical user interface display. In his detailed description, Alexander uses the term "annotation label", which refers to a window that is displayed on a display with a graphical user interface and/or an operating system (column 9; lines 5-7), while the current inventor prefer to use the term "*annotation object*". Both concepts are identical. Alexander's computer system is comprised of a *display unit (*column 8, lines7-8; 112 in Fig 1), preferably a liquid crystal display, for displaying the application window/annotating application; a Label Control Unit (*window shaping unit)*, which provides the operator the capability of determining the shape, size, appearance, and location/position of the annotation object/window (column 2, lines 51-54; column 10, lines 45-50; 204 in Fig 2) within the application window or the

graphical user interface display. While Alexander use a Label Control Unit to perform these multiple operations (shape, size, appearance, and location/position) on the annotated object/window, the current inventor uses separate units/modules for each operation (*window shaping unit and location selector)*; dialog boxes/display windows (*object selector*) are used to *select an annotation object that is additionally written in* (column 2, lines 52-53; column 9, lines 30-33; column 11, lines 9-12). Newly created annotation labels (annotated windows/objects) are located at the location of the cursor. If this cause an overlay of annotation labels at the same location, the newly created labels are displayed in a cascaded fashion (column 17, lines 5-11). With this disclosure, it would be inherent that the annotated object would be displayed in a window having a *TOPMOST attribute*; computer program methods/*sub-routines* (program instructions) for processing/performing different tasks required for creating, modifying, locating, positioning, and displaying the annotation object/window. These software routines are usually stored in memory, and/or disk storage devices, or any other *computer readable medium* such as a compact disc or magnetic tape. Using any of these mediums, the software sub-routines (program instructions) may be loaded into the computer system (column 8; lines 45-49; 117 in Fig 1; 350 in Fig 3B; 352 in Fig 3B; 354 in Fig 3B). In the current invention claims, the computer system *stores the annotation object formed without dependence on an application that constructed said application window.* Alexander discloses that his invention is not limited to a particular computer platform, operating system, processor, or high level programming language (column 8, lines 57-61). With this disclose, it would be inherent that Alexander's invention also executes

independently of the application that constructed the application window within computer system.

Alexander does not disclose expressly *transmitting to said plurality of interconnected hosts a request event for sharing of said annotation object, so that said annotation object can be shared by said plurality of hosts.*

However, Eintracht et al discloses a system that provides collaborative document annotation by remote users, whereby notes or annotations associated with a document are stored on a web server (column 2, lines 8-11). Clients/*hosts* are able to create, store, edit, and retrieve annotations related to specific documents located on the server. When annotations are posted to the server, the database is synchronized such that other clients can retrieve the current up-to-date annotations (column 2, lines 59-61). Once the user synchronizes the database with his/her changes, the server transmits back an acknowledgement along with any new notes that other clients may have posted since the last synchronization was performed (column 2, lines 44-45). Eintracht's system also has an option whereas the server can be adapted to trigger one or more alarms in response to a change being made in the database. Those clients that wish to be notified in the event of a database change *(a request event for sharing of said annotation object)* at the server can be notified by visual indications, audio, and/or email (column2, lines 63-67).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Eintracht's teaching of collaborating annotated documents with Alexander's teaching of annotating a graphical interface display, for the benefit of a

host computer/client being able to collaborate with other clients within the same network to share annotations, modifications, updates, or provide various information within an application remotely.

With respect to dependent claims 2, 10, 14, and 15, these claims incorporate substantially similar subject matter as claimed in claims 6,13, and 18. They are rejected along the same rationale.

With respect to dependent claims 3 and 9, Alexander discloses that the annotation label (annotation object) may be rendered in one of three background transparency styles: opaque, inverted, and *transparent* (column 19, lines 9-11). Transparent results in blank regions on the annotated label being rendered, such that the underlying data is visible through the annotated label (annotation object) (column 19, lines 14-17). The operator is also provided a menu item to select whether the annotated label (annotated object) is to be outlined. This outline is a border that is drawn around the annotated label rectangle (column 19, lines 26-28; 920 in Fig 9), which stores the annotated object.

With respect to dependent claim 4, Alexander discloses the annotation system generates a move label (annotation object) command to the Control Label Unit to change the location of the annotated label (annotation object) from the default location if there is a position conflict (column 16, lines 57-61). It is also possible to position the

annotated label (annotation object) by positioning the cursor over a desired annotation label and graphically move it to a desire location within the display region (column 16, line 67; column 17, lines 1-2; column 17, lines 42-44).

With respect to dependent claim 5, Alexander does not disclose expressly *steps of receiving from said plurality of interconnected hosts images displayed in said application window when said images displayed on the desktop by the said plurality of host differ.*

However, Eintracht et al teaches when updates are posted to the server, the database is synchronized such that other clients can retrieve the current up-to-date annotations (column 2, lines 59-61). After the user synchronizes the database, the server transmits back an acknowledgement along with any new notes that other clients may have posted since the last synchronization was performed (column 2, lines 44-45).

At the time of the invention, it would have been obvious to a person skilled in the art to combine Eintracht et al with Alexander for the benefit of ensuring that all clients within the network will display the same/most current display image for each annotated object, whether the object is displayed on the desktop of within the application window.

With respect to dependent claims 7and 12, Alexander discloses that a rectangle limit command *(region function)* that provides the dimensions of the display region in which the annotated label (annotated object) may be positioned (column 17, lines 54-56; 226 in Fig 3A; 802A in Fig 8). The Limit Rectangle Logic Unit stores these values and forwards them to each Label Control Unit in rectangle limits commands (column 23, lines 2-4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James J. Debrow
Examiner
Art Unit 2176

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
10/13/2005